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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,597	03/13/2001	Carolyn W. Hall	HALL-101	4573

7590 02/11/2003
Robert K. Tendler
65 Atlantic Avenue
Boston, MA 02110

EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,597

Applicant(s)

HALL ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/14/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the single step claim (i.e. automatically transmitting), where a method step recitation does not appear in combination with another recited method step, it is subject to undue breadth rejection. The single method step is incapable of performing the stated function "increasing retention in the learning process". Claims 3, 4, and 12 recite the limitation "the responses", claim 12 recites the limitation "the receipt, and claim 15 recites the limitation "the activity". There is insufficient antecedent basis for this limitation in the claim. Regarding claim 7, the limitation that the "mini-object lessons are in the nature of guided practice" is vague and indefinite. Further claim 11, recites the limitation "respond with same action", the meaning of this phrase is unclear. The term is not defined by the claim, nor is it clearly described in the specification.

Claims 2, 5, 6, 8-10, 13, 14, and 16-20 are rejected for their incorporation of at least one of the above through their dependencies.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fargano (US 6257896 B1). Fargano teaches a method for transmitting questions for a user that can be interpreted as the method for increasing retention in the learning process as claimed. The step of automatically transmitting to an individual learning tasks to be performed multiple times during the day from an Internet Site, thus to provide the individual with an active learning experience pushed from the Internet site "at" pre-selected times during the day, as in claim 1, is taught in col. 1: 36-40, and further in col. 5: 14-18. The learning task device capable of communicating the learning task, as in claim 2, equates to the "communication device" which the user of the Fargano invention is provided. Identifying responses of the individual and transmitting the responses back over the Internet to the Internet Site, as in claim 3, is taught at col. 3: 10. Altering the individual learning tasks from the Internet site responsive to the responses of the individual to prior learning tasks from the Internet site, claim 4, equates to the adaptive system as taught at col. 2: 45-47. The learning tasks being time limited so as not to interfere with the normal tasks of the individual (claim 5) and the automatic transmission being at a pace so as not to disrupt the individual during his workday (claim 10), are taught at col. 4: 59-61 and col. 3: 35. The mini-object lessons of claim 6, corresponds to the "instructions" of the Fargano invention. The limitations of claims 7 and 8 are taught by the example given at col. 7: 14-22. Figure 4 teaches receipt of the learning task being indicated by the response of the individual to the learning task. Improving competency in the work place (claim 13) is deemed to be identical to the "skills building" of the Fargano patent.

It is noted that Fargano does not specifically state that the tasks are transmitted from an Internet site (claim 1 and its dependents). However, the Internet site is deemed to be substantially identical to the

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server system underlying the Fargano method. As an Internet Site does not actually have the capability to transmit data, but rather the underlying software and hardware functionalities associated with the site. Fargano further does not specifically disclose that the "communication device" is a computer or a personal digital assistant (PDA). Fargano gives examples of the communication device being e-mail, voice mail, a cellular phone, or a pager. E-mail is well known to be receivable of PDAs and personal computers. As such, these devices are deemed to be functional equivalents.

Regarding claims 14-20, Fargano does not teach that the tasks are directed to an athletic activity (claim 14), namely golf (claim 15), empower women to react to specific workplace encounters with positive results (claim 16), improve the response of an individual to health related issues (claim 17), namely weight (claim 18), addiction (claim 19) and the taking of medication (claim 20). It is the examiner's position that the particular type of educational content transmitted to the user is a non-patentably distinct feature. Each of the areas above are well-known areas of education, and as such it would be obvious to one of ordinary skill in the art to the invention of Fargano to adapt the tasks to be directed to any of the above areas.

Claims 21-25 correspond to a system of substantially similar scope as claims 1-4, respectively and are rejected for the same reasons.

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Graves (US 4593904) teaches a system for presenting questions to a user through a communication network
 - b. Wicks (US 5942969) teaches a game where clues are sent to a user through a pager system
 - c. Miles et al (US 6102406) teaches an Internet based scavenger hunt

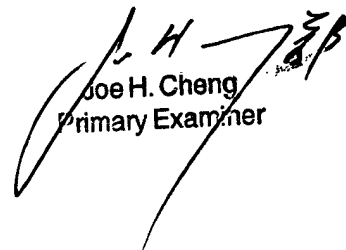
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Kathleen M. Christman
January 30, 2003


Joe H. Cheng
Primary Examiner